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09/291,656	03/03/1999	MARC PETERS-GOLDEN	UM-03662	2349
7590 Medlin & Carroll LLP 101 Howard Street Suite 350 San Francisco, CA 94105			EXAMINER CARLSON, KAREN C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARC PETERS-GOLDEN and THEODORE STANDIFORD

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Appeal 2009-010658  
Application 09/291,656  
Technology Center 1600

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Decided: November 17, 2009

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Before ERIC GRIMES, LORA M. GREEN, and  
RICHARD M. LEBOVITZ, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to an aerosol composition, which the Examiner has rejected the claims as anticipated or obvious. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

## STATEMENT OF THE CASE

This application was the subject of an earlier appeal to this Board (Appeal 2007-1145, decided May 30, 2007). At the time, claim 22 read as follows:

22. A solution for the treatment of a microbial infection, said solution comprising a sterile liquid vehicle, an antibiotic and a leukotriene dissolved in said sterile liquid vehicle, wherein said solution is an aerosol.

(2007 Decision, page 2.)

Appellants had defined an “aerosol” as either a “gaseous suspension of fine solid or liquid particles” or as a substance “packaged under pressure with a gaseous propellant for release as a spray of fine particles” (*id.* at 3). We interpreted claim 22 as “directed to a composition comprising the recited elements, in a form which is either a gaseous suspension of particles or packaged under pressure with a gaseous propellant” (*id.*)

The Examiner had rejected claims 22-25 and 27 as obvious in view of Gosselin.<sup>1</sup> We found that claim 22 read on the solution disclosed by Gosselin, for the following reason:

Gosselin does not disclose a solution in the form of a gaseous suspension or under pressure with a gaseous propellant. However, a solution is not changed by the composition of the gas overlying it or the pressure of that gas. A solution comprising a leukotriene, an antibiotic, and a sterile liquid vehicle is the same solution regardless of whether the solution is in an open container (i.e., under air at atmospheric pressure) or whether it is “packaged under pressure with a gaseous propellant.” Thus, claim 22’s limitation that the “solution is an

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<sup>1</sup> Gosselin et al., U.S. Patent 5,789,441, issued Aug. 4, 1998.

aerosol” does not distinguish the claimed solution from the solution disclosed by Gosselin and the ‘059 Application [to which Gosselin claimed priority].

(*Id.* at 7-8.)

Because our reasoning differed from that of the Examiner, we designated the affirmance based on Gosselin a new ground of rejection (*id.* at 8). Appellants elected to reopen prosecution and amended the claims. The Examiner rejected the amended claims and this appeal followed.

Claims 22-25, 27, and 38 are pending and on appeal. Claim 22 is the only independent claim and reads as follows:

22. An aerosol for the treatment of a microbial infection, said aerosol comprising a sterile vehicle and a leukotriene dissolved in said vehicle, wherein said aerosol comprises a gaseous suspension of fine or liquid particles.

The claims stand rejected as follows:

- Claims 22-25 and 27 under 35 U.S.C. § 102(e) as anticipated by Gosselin (Ans. 4); and
- Claims 22 and 38 under 35 U.S.C. § 103(a) as obvious in view of Gosselin (Ans. 5).

## GOSSELIN

### *Issue*

The Examiner finds that Gosselin’s disclosure of “leukotriene LTB<sub>4</sub> in a sterile liquid” (Ans. 4) anticipates claims 22-25 and 27 and would have made obvious the additional limitation of claim 38 (*id.* at 5). The Examiner bases her position on the reasoning in the 2007 Decision that

a solution comprising a leukotriene, an antibiotic, and a sterile liquid vehicle is the same solution regardless of whether the

solution is in an open container (i.e., under air at atmospheric pressure) or whether it is “packaged under pressure with a gaseous propellant.” Thus, claim 22’s limitation that the “solution is an aerosol” does not distinguish the claimed solution from the solution disclosed by Gosselin.

(Ans. 5.)

Appellants contend that “the Examiner has misinterpreted the Board’s analysis in the previous appeal” (Appeal Br. 6). Appellants contend that the

Board merely held that when a claim is phrased as “a solution in the form of an aerosol” and the definition of “aerosol” in the specification might encompass a “solution under pressure” then Gosselin et al. is allegedly prior art. The Board did not hold that when a claim is phrased as “an aerosol” and further limited to “a gaseous suspension of fine or liquid particles” then Gosselin et al. is prior art. In fact, Gosselin et al. does not disclose “a gaseous suspension” and therefore cannot anticipate the Applicant’s claimed embodiment.

(Reply Br. 2-3.)

The issue presented is: Did the Examiner err in concluding that claim 22, as presently written, is anticipated by Gosselin under the reasoning of the 2007 Decision?

### *Findings of Fact*

#### 1. The 2007 Decision held:

The present application claims an effective filing date of December 3, 1996. The Application that issued as Gosselin was filed after December 3, 1996, but claims the benefit of [application 08/602,059], which was filed February 15, 1996. Thus, Gosselin appears to be prior art under 35 U.S.C. § 102(e) as to any subject matter described in Gosselin that is supported by the ‘059 Application.

(2007 Decision, page 6.)

2. Gosselin discloses that “[d]osage forms include . . . aerosols” (Gosselin, col. 11, ll. 31-32).

3. The ‘059 Application discloses *in vitro* experiments using “different concentrations of LTB<sub>4</sub>” (‘059 Application 13: 14 and 14: 22-23).

4. The ‘059 Application does not disclose a leukotriene-containing formulation in aerosol form or in any other form that would reasonably be interpreted to be “a gaseous suspension of fine or liquid particles,” as recited in claim 22.

#### *Principles of Law*

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

#### *Analysis*

We agree with Appellants that the rejections on appeal are based on a misinterpretation of the 2007 Decision. That decision did not hold that Gosselin’s disclosure of an aerosol is entitled to the filing date of Gosselin’s earlier application, thereby making it prior art with respect to the present claims. Gosselin’s earlier application did not disclose formulations in the form of an aerosol, and therefore that disclosure in Gosselin is not prior art with respect to the present claims.

The 2007 Decision held that Appellants had defined an “aerosol” as a composition in one of two forms: either a “gaseous suspension of fine solid or liquid particles” or as a solution “packaged under pressure with a gaseous

propellant for release as a spray of fine particles” (2007 Decision, page 3). We concluded that the latter definition read on Gosselin’s solution, even though it was not packaged under pressure, because “a solution is not changed by the composition of the gas overlying it or the pressure of that gas” (*id.* at 7).

The 2007 Decision did not hold that Gosselin disclosed a composition meeting the first of Appellants’ alternative definitions of an “aerosol.” Although Gosselin discloses an “aerosol” dosage form, that disclosure is not prior art with respect to the present claims because it lacks support in the ‘059 Application.

The claims have now been amended to be limited to an aerosol meeting that definition; specifically, “a gaseous suspension of fine or liquid particles.” Gosselin, to the extent that its disclosure qualifies as prior art with respect to the present claims, does not disclose a composition in the form now claimed.

### *Conclusion of Law*

The Examiner erred in concluding that claim 22, as presently written, is anticipated by Gosselin under the reasoning of the 2007 Decision.

### SUMMARY

We reverse the rejection of claims 22-25 and 27 as anticipated by Gosselin, and the rejection of claims 22 and 38 as obvious in view of Gosselin.

### REVERSED

Appeal 2009-010658  
Application 09/291,656

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